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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,676	07/08/1999	KRISTEN DIANE ONDECK	PHA-23.681	6934

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EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/349,676	ONDECK KRISTEN DIANE
	Examiner Jean D Janvier	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 January 2004.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 10-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \*    c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**Response To Applicant's Amendments**

The Examiner approves the new title of the invention and the changes made to the claimed invention to overcome the 101 Rejection as stated in the advisory action in response to the amendment filed under 1.116 (see paper no. 22).

***Response to Arguments***

In view of the Appeal Brief filed on January 26, 2004, PROSECUTION IS HEREBY REOPENED, as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Applicant's arguments, as herein presented, are based on the newly amended claims and are fully addressed in the present Office Action. In other words, Applicant's arguments are moot in view of new grounds of rejection.

**DETAILED ACTION**

*Specification*

**Status of the claims**

Claims 1-9 were canceled and claims 10-24 were added. Claims 10-24 are now pending in the Instant Application.

*Claim Objections*

Claim 12 is objected to because of the following informalities:

Concerning claim 12, the information provided in the specification discloses “wherein the base product comprises an electronic device selected from the group **comprising** a remote control, a personal digital assistant, a television receiver and a radio”. Therefore, the claim will be examined accordingly. Further, the limitations of the claim are treated in the alternative.

Appropriate correction is required.

*Duplicate Claims*

Claim 10 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 20. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. Claim 10 replaces the term entity, recited in claim 24, with the term retailer. Further, claim 10 recites “...electronically receiving registration information from a purchaser of at least one base product...”, while claim

24 recites "...electronically receiving registration information...". However, it is expected in claim 24 that the **registration information is received from a purchaser of at least one base product**. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10, 20, 11-14, 16-17, 21 and 22 are rejected under 35 USC 102(e) as being anticipated by Goldman 6, 473, 099B1.

As per claims 10 and 20, Goldman teaches a system for automatically upgrading or updating Software, over a communication link such as a satellite link in conjunction with the Internet, currently installed or running on a client machine or base product (computer, WebTV set-top-box, handheld device or PDA) when such an upgrade or update or customization information, such as an Internet browser upgrade or patch or any other content, becomes available at a Remote Server or WebTV Server (base product running an upgradeable Software and operable to receive, install and store a software update thereon). The download of the upgrade to the client may be mandatory or optional and thus, the mandatory upgrade may be

performed automatically whereas the user of the client or base product may be prompted to decide whether to accept the optional upgrade (transmitting download instructions to the user of the base product or client to accept a transmitted or upcoming customization information whose content may be related to a browser update, system Software, Application Software encoded thereon). The system eliminates the need for the client to be actively communicating with network infrastructure for the download to occur and enables the download to take place during low traffic time. The download requires little or no input from the user at the client.

It should further be understood that upon purchasing, from a participating retailer, a client device or machine (base product), such a computer, WebTV having a set-top box, handheld device or PDA, etc., the purchaser or the customer or the user must fill out a registration form, where he specifies, among other things, the retailer or the retail store location where he purchases the client or base product, his address, the type of client purchased, the client identifier or serial number, the type of OS and other Software installed in the client (or computer or handheld device), date of purchase or where the user or purchaser provides answers to a questionnaire associated with the registration form, wherein the registration form is subsequently mailed to the manufacturer to thereby guarantee the purchased product or base product in case the purchased item or product becomes defective or to provide technical support to the customer or purchaser when needed and to further target the user or the purchaser of the base product (registration process), as practiced in the art. It is herein understood that the system uses the registration information provided on the registration form by the purchaser to push or transmit customization information or content, such as an OS update or a browser update or patch or system Software update, application Software upgrade, etc., based on the information supplied

by the purchaser on the registration form, that is the type of client purchased, the client identifier, the retailer associated with the purchased client (retailer's identity), the type of OS or software pre-installed at the factory, the date of purchase of the client, etc. Finally, the steps of providing for sale at least one of the manufacturer's clients or base products, such as a Web TV, a computer, a handheld device, etc., via one or more distributors to a plurality of participating retailers are implicitly supported or anticipated by Goldman.

(See abstract; figs. 1, 3 and 6-11; col. 2: 12-62; col. 4: 19-64; See also claims 2, 5, 10 and 23 of the Goldman's reference).

As per claims 11-14, 16-17, 21 and 22, Goldman teaches a system for automatically upgrading or updating Software, over a communication link such as a satellite link in conjunction with the Internet, currently installed or running on a client machine or base product (computer, WebTV set-top-box, handheld device or PDA) when such an upgrade or update or customization information, such as an Internet browser upgrade or patch or any other content, becomes available at a Remote Server or WebTV Server (base product running an upgradeable Software and operable to receive, install and store a software update thereon). The download of the upgrade to the client may be mandatory or optional and thus, the mandatory upgrade may be performed automatically whereas the user of the client or base product may be prompted to decide whether to accept the optional upgrade (transmitting download instructions to the user of the base product or client to accept a transmitted or upcoming customization information whose content may be related to a browser update, system Software, Application Software encoded thereon). The system eliminates the need for the client to be actively communicating with

network infrastructure for the download to occur and enables the download to take place during low traffic time. The download requires little or no input from the user at the client.

It should further be understood that upon purchasing, from a participating retailer, a client device or machine (base product), such a computer, WebTV having a set-top box, handheld device or PDA, etc., the purchaser or the customer or the user must fill out a registration form, where he specifies, among other things, the retailer or the retail store location where he purchases the client or base product, his address, the type of client purchased, the client identifier or serial number, the type of OS and other Software installed in the client (or computer or handheld device), date of purchase or where the user or purchaser provides answers to a questionnaire associated with the registration form, wherein the registration form is subsequently mailed to the manufacturer to thereby guarantee the purchased product or base product in case the purchased item or product becomes defective or to provide technical support to the customer or purchaser when needed and to further target the user or the purchaser of the base product (registration process), as practiced in the art. It is herein understood that the system uses the registration information provided on the registration form by the purchaser to push or transmit customization information or content, such as an OS update or a browser update or patch or system Software update, application Software upgrade, etc., based on the information supplied by the purchaser on the registration form, that is the type of client purchased, the client identifier, the retailer associated with the purchased client (retailer's identity), the type of OS or software pre-installed at the factory, the date of purchase of the client, etc. Finally, the steps of providing for sale at least one of the manufacturer's clients or base products, such as a Web TV, a

computer, a handheld device, etc., via one or more distributors to a plurality of participating retailers are implicitly supported or anticipated by Goldman.

(See abstract; figs. 1, 3 and 6-11; col. 2: 12-62; col. 4: 19-64; See also claims 2, 5, 10 and 23 of the Goldman's reference).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al., US Patent 6, 473, 099 B1.

As per claims 18-19 and 24, Goldman does not expressly disclose providing advertising space on a web page for the retailer (displaying an advertisement or publicity on a manufacturer's or distributor's website for the retailer), who sold the base product to the purchaser accessing a portal.

However, it is common practice in the art for a product manufacturer to include in his product literature the names of the distributors and/or retailers distributing and/or selling the manufacturer's products and services. Furthermore, the manufacturer can display on a web page related to the manufacturer's web site the participating distributors and/or retailers carrying

and/or selling the manufacturer's products to an end-user accessing the manufacturer's website (portal) and requesting product information. In addition, a distributor distributing the manufacturer's products can also provide information on his website regarding participating retailers selling the manufacturer's products in a particular geographic location to a visitor or user accessing the distributor's website (portal). Here, providing, by a manufacturer and/or distributor on his website and/or product literature information about a retailer, including the retailer's location and/or web site, selling the manufacturer's products and services, represents a free advertising, a patronage or a publicity (sale lead) on behalf of the retailer selling the manufacturer's products in a specific geographic location, wherein the free advertising is printed in the manufacturer's and/or distributor off-line product literature and/or displayed on the manufacturer's and/or distributor's website to an end-user accessing the web site and requesting product information.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into Goldman's system so as to display to a user or purchaser, visiting a manufacturer's or distributor's website and request product information related to the manufacturer, an advertising message (publicity or patronage) showing among other things a participating retailer's name, geographic location and/or website address selling the manufacturer's products in a particular geographic location, thereby providing to a user or customer accessing a product manufacturer's and/or distributor's website important information including a participating retailer's website address and/or geographic location proximate to the user's geographic location where the customer or user can purchase at least one of the manufacturer's products or base products (sale leads), while encouraging the customer or user

visiting the manufacturer's and/or distributor's website to buy the manufacturer's product brand sold at the retailer's local store, wherein this sale lead or referral helps the retailer sell the manufacturer's products and increase the retailer's bottom line and the manufacturer's market share for the at least one product or base product in an era of tough competition.

As per claim 23, Goldman does not teach the steps of obtaining a base product by lease.

However, it is well established in the industry that a customer can lease, for instance, for a short or a long period of time a base product, such as a computer, a piece of furniture, a TV set, a car, etc., instead of buying the base product from a retailer by signing an agreement wherein the customer might in the end after a certain period of time purchase the used or leased or now depreciated item for at a low price, thereby saving money on maintenance and repair cost that is usually associated the ownership of a base product, such as a computer, a car, a TV set, etc., once the base warranty period expires.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the Goldman's system so as to allow a user or customer to lease a base product, such as a computer, a car, a TV set, etc., instead of buying the base product, thereby making it easier for more consumers, who could not otherwise afford to buy the base product in the first place, to obtain by leasing and use the base product, while increasing the base product consumption or usage among the consumers and the manufacturer's market share related to the base product and while enabling the consumers or users to save

money on maintenance and repair cost that is usually associated with the ownership of a base product, such as a computer, a car, a TV set, etc., once the base warranty period expires.

### **Conclusion**

Although the following references were not officially used in the office action, they were considered as relevant prior art. Applicant is further directed to review these references.

US Patent 5,991,739 to Cupps teaches an Internet Online ordering method and system for providing product information and product distribution (product ordering) to a user using a client computer connected to a distributed computer system (having at least one web server or Internet appliance). The Online ordering or system provides the user or customer with product information from various vendors whose delivery range is within the customer's geographical location. A vendor's and customer's locations are associated with a geocode representing the latitude and longitude coordinates (geographic identifiers) of a geographic location of interest to both the vendor and the user or customer. In fact, when the customer accesses the Online ordering machine or system over the Internet to order at least one product, the customer inputs the delivery location or geographic location (and other information) where he wants the at least product to be delivered. Upon receiving the inputted or entered information or geographic location having specific parameters or coordinates (latitude or longitude), the system searches or queries, using the geocodes (radius) corresponding to the user's inputted location and prospective vendors' locations, a database (coupled to a readable medium or carrier medium) for vendors servicing the customer's location and selling products including the ordered

product. At the conclusion of the search, a list or group of vendors (search result) servicing the user's location is displayed on a customized menu of a web page and wherein a vendor servicing the user's geographical location is selected by the user from the group of vendors (search result listing) to process the order in accordance with the geocodes or longitude and latitude coordinates (geographic identifiers) related to the user's and the selected vendor's locations (See abstract; figs.1, 4, 8-9 and 10-12; col. 2: 20-61; col. 6: 19 to col. 8: 16; col. 8: 43 to col. 10: 25).

US Patent 6,009,274A to Fletch discloses a method for automatically updating Software components on a client over a network.

US Patent 6, 047, 273A discloses a system and method for remotely providing a remote shipping software upgrade.

US Patent 6, 418, 555 B2 to Mohammed discloses a method for automatically updating Software components on a client over a network.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325



JDJ  
04/12/04